

REMARKS

In the September 21, 2010 Office Action, claims 1-6 and 21-23 stand rejected in view of prior art, while claims 8-20 were indicated as containing allowable subject matter by the Examiner via telephone on December 16, 2010. Claims 2-4, 6-20 and 23 were rejected as being indefinite for failing particularly point out and distinctly claim the subject matter that Applicant regards as the invention. No other objections or rejections were made in the Office Action.

Status of Claims and Amendments

In response to the September 21, 2010 Office Action, Applicants have amended the specification and claims 1, 2, 4 and 6-23, and canceled claim 5, as indicated above. Claims 7-20 have been put into independent form. Thus, claims 1-4 and 6-23 are pending, with claims 1 and 7-20 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

Informal Telephone Call With Examiner Martinell

On December 16, 2010, the undersigned contacted Examiner Martinell who is in charge of the above-identified patent application. Applicants wish to thank Examiner Martinell for the opportunity to informally discuss the above-identified patent application.

During the telephone conversation, Examiner Martinell indicated that claims 8-20 would appear to be allowable, if written in independent form and if the 35 USC § 112 objection and rejections were overcome.

Specification

On page 2 of the Office Action, the specification was objected to for inclusion of a hyperlink. Applicants have amended the specification to remove the hyperlink.

Applicants believe that the specification is now correct and complies with MPEP 608.01. Withdrawal of the objections is respectfully requested.

Claim Objections - 35 U.S.C. §112

On page 2 of the Office Action, claim 4 was objected to for inclusion of an informality. In response, Applicants have amended claim 4 to correct the informality.

Withdrawal of the rejections is respectfully requested.

Claim Rejections - 35 U.S.C. §112

On page 2 of the Office Action, claims 2-4, 6-20 and 23 were rejected under 35 U.S.C. §112, second paragraph. In response, Applicants have amended claims 2, 4, 6-20 and 23 to clarify the claims.

Specifically, claim 2 has been amended to replace the term aspiration amount with *a consumed amount of oxygen*. Claim 6 has been amended to correlate the term unclassified and unclassified protein with their respective classification numbers.

Claim 7 has been amended to include a specific group of genes.

Claim 23 has been amended to clarify the wording of the claim.

Applicants believe that the claims now comply with 35 U.S.C. §112, second paragraph. Withdrawal of the rejections is respectfully requested.

Rejections - 35 U.S.C. § 102 – Claims 1, 2 & 21-23

On page 3 of the Office Action, claims 1, 2 and 21-23 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,948,612 (hereinafter the “Bascomb et al. patent”) or the Monarca et al. publication. In response, Applicants have amended

independent claim 1 to clearly define the present invention over the prior art of record.

Claims 21-23 have been amended to depend from amended independent claim 1.

In particular, independent claim 1 has been amended to recite the subject matter of claim 5. Specifically, independent claim 1 recites culturing a gene-disrupted strain of a yeast. As well, independent claim 1 has been further amended to recite that *the gene-disrupted strain is a strain of yeast containing about 1 kb of a gene-disrupted strain transformation cassette in which the gene-disrupted strain to the chemical is replaced with a transformation marker.*

Clearly, these amendments to claim 1, in combination with the original recitation in claim 1, are *not* disclosed or suggested by the Bascomb et al. patent, the Monarca et al. publication, or any other prior art of record. It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference. Therefore, Applicants respectfully submit that claim 1, as now amended, is not anticipated by the prior art of record. Withdrawal of this rejection is respectfully requested.

Moreover, Applicants believe that dependent claims 2 and 21-23 are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Also, dependent claims 2 and 21-23 are further allowable because they include additional limitations. Thus, Applicants believe that since the prior art of record does not anticipate the independent claim 1, neither does the prior art anticipate the dependent claims.

Applicants respectfully request withdrawal of the rejections.

Rejections - 35 U.S.C. § 102 – Claims 1-6, 21-23

On page 3 of the Office Action, claims 1-6 and 21-23 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Published Application No. 2003/0180953 (hereinafter the “Roemer et al. publication”). In response, Applicants have amended independent claims 1, 21, 22 and 23 to clearly define the present invention over the prior art of record. Claims 21 and 22 have been amended to depend from amended independent claim 1. The subject matter of dependent claim 5 has been added to independent claim 1, and claim 5 has been canceled. Claims 21-23 now depend from independent claim 1.

As mentioned above, independent claim 1 has been amended to recite culturing a gene-disrupted strain of a yeast to recite that *the gene-disrupted strain is a strain of yeast containing about 1 kb of a gene-disrupted strain transformation cassette in which the gene-disrupted strain to the chemical is replaced with a transformation marker.*

Clearly, these amendments to claim 1, in combination with the original recitation in claim 1, are ***not*** disclosed or suggested by the Roemer et al. publication or any other prior art of record. It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference. Therefore, Applicants respectfully submit that claim 1, as now amended, is not anticipated by the prior art of record. Withdrawal of this rejection is respectfully requested.

Moreover, Applicants believe that dependent claims 2-4, 6 and 21-23 are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Also, dependent claims 2 and 21-23 are further allowable because they include additional limitations. Thus, Applicants believe that since the prior art of record does not anticipate the independent claim 1, neither does the prior art anticipate the dependent claims.

Appl. No. 10/581,085
Amendment dated February 22, 2011
Reply to Office Action of September 21, 2010

Applicants respectfully request withdrawal of the rejections.

Allowable Subject Matter

As conveyed by Examiner Martinell during the December 16, 2010 telephone discussion, claims 8-20 were indicated as containing allowable subject matter. Applicants wish to thank the Examiner for this indication of allowable subject matter and the thorough examination of this application. In response, Applicants have amended claims 8-20 to place them in independent form. Thus, independent claims 8-20 are believed to be allowable.

Similarly, claim 7 has also been put into independent form and has further been amended to recite that the gene to be disrupted is involved in a vacuole *which is one of YKL080W, YLR447C, YHR06W, YPR036W, YHR039C-A or YHR026W*. Since no prior art rejections were applied to claim 7, Applicants assert that independent claim 7 is also allowable.

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In view of the foregoing amendment and comments, Applicants respectfully assert that claims 1-4 and 6-23 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,

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